

Notice of Allowability

Application No.

10/524,451

Examiner

Yong Chu

Applicant(s)

TAHRI ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/05/2006.
2. ☒ The allowed claim(s) is/are 1-6, 8, 12, 14, 16, 18 and 20-23.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

Claims 7, 9-11, 13, 15, 17, and 19 have been canceled by the Amendment filed on 5 October 2006. Claims 21-23 have been added by the Amendment. Claims 8, 14, and 18 have been amended by the Amendment. Therefore, claims 1-6, 8, 12, 14, 16, 18, and 20-23 are pending in this application.

Claims 1-6, 12, 16, and 20-23 are directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(b), claims 8, 14, and 18, directed to the process of making or using the allowable product, previously withdrawn from consideration as a result of a restriction requirement, claims 8, 14, and 18 hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Because a claimed invention previously withdrawn from consideration under 37 CFR 1.142 has been rejoined, **the restriction requirement groups as set forth in the Office action mailed on 18 January 2006 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Response to Amendment

The Amendments by Applicants' representative Alana G. Kriegsman dated on 8 October 2006 and 18 september 2006 have been entered.

Rejection under 35 U.S.C. §112, second paragraph

Applicants have amended claim 1 by deleting the term "metabolite" based on the suggestion by Examiner at the previous office action.

Applicants have amended claims 8, 14, and 18 by deleting the term "combating" based on the suggestion by Examiner at the previous office action.

Therefore, the rejections over the claims are withdrawn.

Rejection under 35 U.S.C. §103(a)

Applicant's argument filed on 18 September 2006 on the ground that the cited prior art WO 99/67254 discloses a series of compounds containing only indole, not indole-2-one as claimed in the instant application. The argument has been considered, and is found persuasive. Therefore, the rejection over the claims is withdrawn.

Examiner's amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

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In claim 1, page 1 line 6 of the Amendment filed on 5 October 2006, insert -- or -- after “..Het¹C₁₋₆alkyl, Het²,”.

In claim 1, page 3 line 9 of the Amendment filed on 5 October 2006, insert--and-- after “.. Het², C₁₋₄alkylcarbonyloxy, ”.

In claim 1, page 3 line 16 of the Amendment filed on 5 October 2006, insert --or-- after “.. nitro, halogen, ”.

In claim 2, page 1 line 1 of the Amendment filed on 5 October 2006, insert -- is -- after “.. claim 1 wherein R₁ ”.

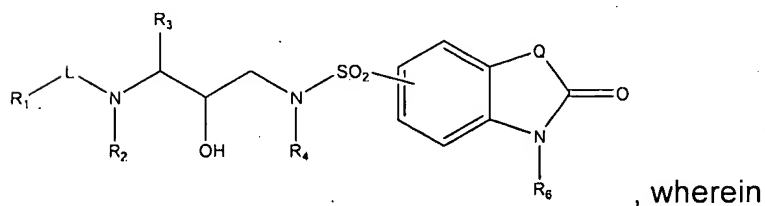
In claim 2, line 3 of the Amendment filed on 5 October 2006, insert -- or -- after “₆alkyl, Het², ”.

In claim 4, line 3 of the Amendment filed on 5 October 2006, delete “or” after “Het¹, Het², ”, and insert -- and --.

In claim 5, add “,” after each listed compound till the second last, and add “, and” after the last listed compound.

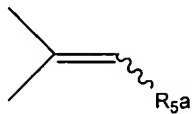
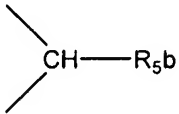
Reasons for Allowance

The present invention is directed to a compound of the formula

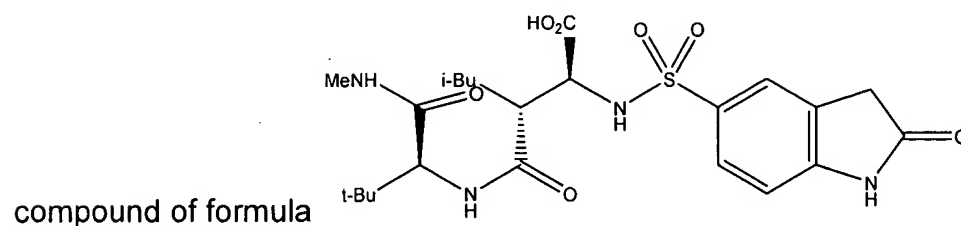


R₄ is H, or C₁₋₆alkyl;

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Q represents  or , and the rest substituents are defined as in claim 1.

The closest prior art of record is WO 9807742 (Barlaam). Barlaam discloses a



The prior art compound is patentably distinct from the instantly claimed compounds and does not share the common core structure.

The method of using claims 8, 14, and 18 have support in the instant specification and the other references cited in the specification, such as WO 95/06030, WO 96/22287, WO 96/28418, WO 96/28463, WO 96/28464, WO 96/28465 and WO 97/18205.

Therefore, claims 1-6, 8, 12, 14, 16, 18, and 20-23 are allowed.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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